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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,547	07/18/2003	Takatoshi Kobayashi	1639.1001D	1327
21171	7590	09/21/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			SOWARD, IDA M	
			ART UNIT	PAPER NUMBER
			2822	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/621,547

Applicant(s)

KOBAYASHI ET AL.

Examiner

Ida M Soward

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7-18-03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7-18-03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

This Office Action is in response to the application filed July 18, 2003.

### *Drawings*

Figures 4 and 9a-9b should be designated by a legend such as --**Prior Art**-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

Claim 1 is objected to because of the following informalities:

in line 10, "." should be deleted.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not understood where each element of the claim resides in the power semiconductor module. Where is each element in relation to one another?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

As best understood, claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art Figures 4 and 9a-9b in view of Sonobe et al. (US 2002/0153532 A1).

In regard to claim 1, Admitted Prior Art Figures 4 and 9a-9b teach a power semiconductor module, comprising: a metal base 1 comprising a heat sink; a semiconductor chip 9; a ceramic substrate 8; a circuit assembly body comprising a ceramic plate 8a, an upper circuit plate 8b, and the ceramic substrate 8, wherein the semiconductor chip 9 is placed on the ceramic substrate 8 which is then placed on the metal base 1; an outer case 2 having terminals formed integrally therein (page 1, paragraph [0004]), wherein the upper circuit plated 8b being joined to the ceramic plate 8a (pages 1-2, paragraphs [0004]-[0007]).

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Also in regard to claim 1 concerning a casting method, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear. As to the grounds of rejection under section 103, see MPEP § 2113.

In regard to claim 2, Admitted Prior Art Figures 4 and 9a-9b teach the power semiconductor module comprises placing at least one ceramic substrate 8 on the metal base 1 (pages 1-2, paragraphs [0004]-[0007]).

However, Admitted Prior Art Figures 4 and 9a-9b fail to teach a casting method integrally molding the metal base on the underside of the ceramic plate, which has no lower plate.

Sonobe et al. teach a casting method integrally molding the metal base 1b on the underside of the ceramic plate 8b, which has no lower plate (Figure 9, pages 4-5, paragraphs [0058]-[0059]).

Since Admitted Prior Art Figures 4 and 9a-9b and Sonobe et al. are from the same field of endeavor (power semiconductor modules), the purpose disclosed by Sonobe et al. would have

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been recognized in the pertinent art of Admitted Prior Art Figures 4 and 9a-9b. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the power semiconductor module structure as taught by Admitted Prior Art Figures 4 and 9a-9b with the power semiconductor module having a casting method integrally molding the metal base on the underside of the ceramic plate, which has no lower plate as taught by Sonobe et al. to provide a high reliability structure of a power semiconductor module (page 3, paragraph [0016]).

### ***Allowable Subject Matter***

Claim 3 is allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose, make obvious, or otherwise suggest the structure of the applicant's together with the other limitations of the independent claims, in particular an upper circuit plate and the metal base formed directly by a formation of a layer of molten metal on an upper face and a lower face of the ceramic plate, respectively.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to power semiconductor modules:

Arai et al. (5,291,065)

Soyano (US 6,396,125 B1)

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Tamba et al. (5,920,119)

Yasukawa et al. (5,793,106).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ida M Soward whose telephone number is 571-272-1845. The examiner can normally be reached on Monday - Thursday, 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on 571-272-1852. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMS  
September 13, 2004

  
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